REMARKS

Claims 50 and 52-59 are pending in this application. Claims 50 and 54-58 have been amended to clarify certain embodiments of the present invention. Specifically, claims 50, 54 and 55 have been amended to replace the term "free therapeutic agent" with "a cytostatic agent, an anti-migratory agent, a cytoskeletal inhibitor, or an anti-matrix agent." New claims 60-65 have been added. Support for the amended claims and new claims can be found in the originally-filed specification as follows:

Claim	Support
50, 54, 55	page 30, line 29 to page 31, line 7
50	page 30, line 34
56	page 31, line 8 to page 32, line 3
57	page 32, lines 17-23
58	page 22, lines 4-6; and page 32, lines 17-20
60	page 32, lines 4-16
61	page 32, lines 3-14
62	page 30, lines 30-35
63	page 31, lines 1-4
64	page 30, line 35 to page 31, line 1
65	page 31, lines 4-7

No new matter has been introduced. Upon entry of the present amendment, claims 50 and 52-65 will be pending in this application.

I. THE WRITTEN DESCRIPTION REJECTION UNDER 35 U.S.C. § 112, FIRST PARAGRAPH, SHOULD BE WITHDRAWN

Claims 50 and 52-59 are rejected under 35 U.S.C. § 112, first paragraph, as allegedly containing subject mater which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventors, at the time the application was filed, had possession of the claimed invention. For the following reasons, Applicants respectfully disagree.

1. The Legal Standard

The test for sufficiency of written description is whether the disclosure of the application "reasonably conveys to the artisan that the inventor had possession" of the claimed subject matter. *In re Kaslow*, 707 F.2d 1366, 1375, 217 U.S.P.Q. 1089, 1096 (Fed. Cir. 1983); accord *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563, 19 U.S.P.Q.2d. 1111, 1117 (Fed. Cir. 1991); *see also*, *Ralston Purina Co. v. Far-Mar-Co, Inc.*, 772 F.2d 1570, 1575, 227 U.S.P.Q. 177, 179 (Fed. Cir. 1985). The criteria for determining sufficiency of written description is set forth in the Guidelines for Examination of Patent Applications Under the 35 U.S.C. 112, ¶ 1, "Written Description" Requirement (the "Guidelines") (published in Volume 66, Number 4, pages 1099-1111 of the Federal Register on January 5, 2001), which specifies that:

> The written description requirement for a claimed genus may be satisfied through sufficient description of a representative number of species by actual reduction to practice (see (1)(a), above), reduction to drawings (see (1)(b), above), or [i] by disclosure of relevant, identifying characteristics, *i.e.*, structure or other physical and/or chemical properties, [ii] by functional characteristics coupled with a known or disclosed correlation between function and structure, or [iii] by a combination of such identifying characteristics, sufficient to show the applicant was in possession of the claimed genus (see (1)(c), above). *Id.* at page 1106, column 3, lines 13-29.

Where the specification discloses any relevant, identifying characteristics, *i.e.*, physical, chemical and/or functional characteristics sufficient to allow a skilled artisan to recognize the applicant was in possession of the claimed invention, a rejection for lack of written description under 35 U.S.C. § 112, first paragraph, is misplaced. *Id.*

2. <u>The Claims Comply With the Written Description Requirement</u>

In the Office Action, the Examiner alleges that the phrase "activity without killing the cell" in claim 50 is not supported by the specification. (Office Action at 3.) Contrary to the Examiner's allegation, page 31, lines 8-24 of the specification clearly provides that "[r]epresentative examples of 'cytostatic agent' ... when delivered into a cellular compartment at an appropriate dosage will act to impair proliferation of a smooth muscle cell or pericyte *without killing the cell*." (emphasis added). The specification clearly describes the subject matter of the claims in such a way as to reasonably convey to one skilled in the relevant art that Applicants, at the time the application was filed, had possession of the

claimed invention. As such, Applicants submit that the originally-filed specification provides support for this recitation.

The Examiner also alleges that the phrase "free therapeutic agent is not heparin ..." in claim 50 is not supported by the originally-filed specification. (Office Action at 3.) As previously discussed in the Amendment filed August 29, 2007 (see page 4), exclusion of one or more species of a genus in a claim is appropriate where the specification provides a generic disclosure of the genus and numerous species within the genus, including the species being excluded from the scope of the claim. *In re Johnson*, 558 F.2d 1008, 1019, 194 U.S.P.Q. 187, 196 (CCPA, 1977) (see also the Manual of Patent Examining Procedure (MPEP), Eighth Edition, Revision 6, Sept. 2007, § 2173.05(i) at page 2100-228). The instant specification provides a generic disclosure of therapeutic agents which are useful in methods for reducing restenosis, including cytostatic agents, anti-migratory agents, cytoskeletal inhibitors, and anti-matrix agents (see, *e.g.*, page 30, line 29 to page 34, line 14), as well as specific disclosure of those therapeutic agents being excluded from the scope of claim 50, *i.e.*, heparin (page 2, line 19), a radioisotope (page 35, line 26), a nitric oxide-releasing compound (page 7, line 25), suramin (page 7, line 24), methotrexate (page 31, line 9), adriamycin (page 31, line 9), a protein kinase inhibitor (page 31, line 11), staurosporin (page 31, line 12), an antisense oligonucleotide (page 8, line 12), colchicine (page 30, line 34), a peptidic inhibitor of a cellular factor that triggers proliferation of a smooth muscle cell or a pericyte (page 31, lines 24-35) (*e.g.*, a growth factor inhibitor, a smooth muscle-derived growth factor inhibitor, an endothelial-derived growth factor inhibitor, a platelet homing receptor inhibitor, and an integrin inhibitor), triazolopyrimidine (page 32, line 2), and a prostaglandin (page 32, line 3). As such, Applicants submit that the negative proviso as recited in amended claim 50 is adequately supported by the specification as originally filed.

In addition, the Examiner alleges that the claims broadly read on any therapeutic agents which encompass inhibitors not contemplated or described by the claimed invention. (Office Action at 3.) Although Applicants disagree, solely to expedite prosecution of the instant application, Applicants have amended claim 50 to recite a cytostatic amount of a cytostatic agent, an anti-migratory agent, a cytoskeletal inhibitor, and an anti-matrix agent. Applicants submit that claim 50, as amended, recites four categories of therapeutic agents, and not just any therapeutic agents.

For the foregoing reasons, Applicants submit that one skilled in the art, based on the disclosure of the specification, would recognize that Applicants were in possession of the claimed methods. Accordingly, Applicants respectfully request that the written description rejection be withdrawn.

II. THE ENABLEMENT REJECTION UNDER 35 U.S.C. § 112, FIRST PARAGRAPH, SHOULD BE WITHDRAWN

Claims 50 and 52-59 are rejected under 35 U.S.C. § 112, first paragraph, allegedly because the specification, while being enabling for a method of reducing restenosis by administering taxol, does not reasonably provide enablement for any therapeutic agent/inhibitor employed by the method. For the following reasons, Applicants respectfully disagree.

1. The Legal Standard

The enablement requirement refers to the requirement of 35 U.S.C. § 112, first paragraph, that the specification describe (1) how to make and (2) how to use the invention. *See* MPEP § 2164. The test for enablement is whether one reasonably skilled in the art could make or use the invention, without undue experimentation, from the disclosure in the patent specification coupled with information known in the art at the time the patent application was filed. *United States v. Telectronics Inc.*, 857 F.2d 778, 8 U.S.P.Q.2d 1217 (Fed. Cir. 1988). Enablement is not precluded even if some experimentation is necessary, provided the experimentation required is merely routine. *In re Wands*, 858 F.2d 731, 737, 8 U.S.P.Q.2d 1400, 1404 (Fed. Cir. 1988) (citing *In re Jackson*, 217 U.S.P.Q. 804, 807 (Bd. Pat. App. & Inter. 1982)). The fact that experimentation may be complex does not necessarily make it undue, if the art typically engages in such experimentation. *In re Certain Limited-Charge Cell Culture Microcarriers*, 221 U.S.P.Q. 1165, 1174 (Int'l Trade Comm'n 1983).

2. The Claims Are Enabled by the Specification

In the Office Action, the Examiner alleges that the specification does not reasonably provide enablement for any therapeutic agent/inhibitor employed by the claimed method. (Office Action at 5.) Contrary to the Examiner's allegation, the claims are fully enabled by the specification such that one skilled in the art can make and use the invention commensurate in scope with amended claims without undue experimentation. As previously

discussed in the Amendment filed August 29, 2007 (see pages 6-7), the specification teaches that the therapeutic agent useful in the claimed method can be a number of drugs (see, *e.g.*, page 30, line 24 to page 34, line 17), and that a cytostatic amount of the therapeutic agent inhibits a vascular smooth muscle cell activity without killing the cell by exerting a relatively minimum effect on protein synthesis and a relatively larger effect on DNA synthesis (see, *e.g.*, page 35, lines 5-8; and page 68, lines 12-16). The specification also teaches a person skilled in the art how to determine, without undue experimentation, the cytostatic amount of the therapeutic agent (see, *e.g.*, Examples 8 and 10).

Nonetheless, solely to expedite prosecution of the instant application, Applicants have amended claim 50 to replace the term "free therapeutic agent" with "a cytostatic agent, an anti-migratory agent, a cytoskeletal inhibitor, or an anti-matrix agent."

The specification provides numerous examples of a cytostatic agent, an anti-migratory agent, a cytoskeletal inhibitor, and an anti-matrix agent (see, e.g., page 31, line 8 to page 34, line 17). The specification also teaches a person skilled in the art how to determine, without undue experimentation, the cytostatic amount of these agents (see, *e.g.*, page 35, lines 5-8; and page 68, lines 12-16). In fact, the specification provides non-limiting working examples on measuring the cytostatic amount for representative drugs of the agents, *e.g.*, cytochalasin (a cytoskeletal inhibitor) (see, *e.g.*, Examples 8 and 10). Applicants submit that in view of the abundance of guidance in the specification, the quantity of experimentation necessary to practice the present invention would not be unduly burdensome to the skilled artisan. As such, it is believed that the specification adequately teaches how to make and use the invention.

In the Office Action, the Examiner also alleges that claim 58 is not enabled because it is "directed to any derivative thereof or analog thereof, absent guidance as to what the structures look like, to provide correlation between structure and function." (Office Action at 6.) Although Applicants disagree, solely to expedite prosecution of the instant application, Applicants have amended claim 58 to specify that the taxol analog or derivative is taxotere.

For the foregoing reasons, Applicants respectfully request that the enablement rejection be withdrawn.

CONCLUSION

As all rejections are believed to be overcome, all claims are believed to be in condition for allowance. An early notice to that effect would be appreciated. Should the Examiner not agree with Applicants' position, then a personal or telephonic interview is respectfully requested to discuss any remaining issues and expedite the eventual allowance of the application. No fee is believed to be due. If any other fees are due, please charge the required fees to Jones Day Deposit Account No. 50-3013.

Respectfully submitted,

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Enclosures